

**REMARKS**

By the foregoing Amendment, Claims 1 and 25 are amended. Entry of the Amendment, and favorable consideration thereof, is earnestly requested. Claims 10-12 and 18-24 having been cancelled previously, Claims 1-9, 13-17 and 25 are currently pending.

Claims 1 and 25, the only independent claims, stand rejected under 35 U.S.C. 103(a) as being unpatentable over Fletcher et al. (U.S. Patent No. 6,022,353) in view of Miller et al. (U.S. Patent No. 5,306,285) and Atkinson et al. (U.S. Patent No. 3,033,251). Applicant respectfully asks the Examiner to reconsider this rejection in view of the above Amendments and the below Remarks.

An invention is not patentable "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a). For a claim to be rejected as obvious, the Office is required to determine the scope and content of the prior art, ascertain the differences between the claimed invention and the prior art, and resolve the level of ordinary skill in the art. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007); MPEP § 2141, citing *Graham v.*

*John Deere Co.*, 383 U.S. 1 (1966). This analysis must be set forth explicitly. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). When considering the prior art, the office is required to consider the prior art as a whole, and may not disregard portions of the art which show that an invention is not obvious. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983).

Additionally, it is important to guard against the use of hindsight when evaluating whether a claim is obvious. *E.g.*, *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. As a guard against hindsight, courts have identified certain scenarios in which it is improper to reject a claim as obvious. For example, a claim cannot properly be rejected as obvious when the principle of operation of the prior art would need to be modified to obtain the claimed invention. *In re Ratti*, 270 F.2d 810 (CCPA 1959) (cited in MPEP 2143.01 for the proposition that "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious."). Similarly, if a prior art reference teaches away from a claimed invention, then the claimed invention is not obvious over that prior art. See MPEP § 2145 citing *In re Grasselli*, 713 F.2d 731

(Fed. Cir. 1983). Given these standards, the Office's rejections under 35 U.S.C. § 103(a) cannot be sustained and must be reversed for the reasons set forth below.

It should be noted that Claims 1 and 25 have been amended to even more particularly recite the structural differences between the present invention and the cited prior art. In particular, Claims 1 and 25 have been amended to highlight that the rearward generally flat first section lies in a first plane, that the the forward generally flat second section (including the elongated cutting edge) lies in a second plane, and that the first and second planes are parallel, but offset from one another such that the second plane is further from the manually driven apparatus than the first plane, whereby the second plane is closer to the workpiece during use than is the first plane.

As has already been recognized by the Examiner, neither Fletcher et al. nor Miller et al. discloses, teaches or suggests a stepped configuration wherein two planes, in which the generally flat first and second sections lie, are offset from each other, which is why the Examiner has cited Atkinson et al. Thus, clearly neither Fletcher et al. nor Miller et al. can disclose a stepped configuration having the precise configuration claimed. Applicant respectfully submits that Atkinson et al. also does not disclose, teach or suggest these features.

It is respectfully submitted that Atkinson et al. is not directed to a tool for making workpiece cuts in combination with an apparatus having a power driven output shaft that oscillates about an axis. By contrast the tool according to Atkinson et al. is a sabre saw employing reciprocating (i.e., back and forth) motion, and not oscillatory motion about an axis. As such, the “step” of Atkinson et al. is completely different than the claimed step.

More specifically, as discussed above, Claims 1 and 25 have been amended to require, inter alia, that the step is configured so that the a second plane (in which lies the generally flat forward section and the cutting edge) is offset from, and further away from, the manually driven apparatus than is a first plane (in which lies the generally flat rearward section), whereby the second plane is closer to the workpiece during use than is the first plane. Atkinson et al. does not disclose, teach or suggest or suggest a step that is configured in this way, and indeed it would moreover not have been obvious to have modified Atkinson et al. to be configured in this fashion.

While Applicant understands that the rejection in the outstanding Office Action was based upon an interpretation wherein a line defined by the cutting edge of Atkinson et al. lies in a plane offset with respect to the reciprocating axis, Claims 1 and 25 have been amended to more clearly define the claimed planes. More

specifically, the claimed second plane has been more clearly defined to be that plane in which lies the generally flat forward section and the cutting edge. Thus, for example, looking to Figure 8 of Atkinson et al., the claimed second plane must now be interpreted to be the plane of the paper on which Figure 8 is printed.

Similarly, the claimed first plane has been more clearly defined to be that plane in which lies the generally flat rearward section. Thus, for example, again looking to Figure 8 of Atkinson et al., the claimed first plane must now be interpreted to also be the plane of the paper on which Figure 8 is printed. In view of these amendments, it is clearly the case that the first and second planes of Atkinson et al. are co-planar, and are not at all offset with respect to one another, as is required by amended Claims 1 and 25. The co-planar nature of the blade of Atkinson et al. can also be clearly seen in Figures 3, 4 and 7 thereof, which show end views of various embodiments.

Moreover, it would not have been obvious to have modified Atkinson et al. to arrange the second plane (i.e., the plane in which lies the generally flat forward section and the cutting edge) to be offset from the the first plane (i.e., the plane in which lies the generally flat rearward section). Because Atkinson et al. is directed to a reciprocating sabre saw (unlike the present invention, which employs an oscillatory motion), offsetting the first and second planes with respect to each other would cause the blade to be subjected to an extreme amount of stress,

thereby making blade failure almost certain in a short period of time. Offsetting the first and second planes with respect to each other would also cause a significant amount of twisting to occur during use, thereby rendering the sabre saw extremely difficult to operate. In this regard, it should be noted that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Here, Applicant respectfully submits that modifying Atkinson et al. to offset the first and second planes with respect to one another, rather than having them be co-planar, would cause significant problems, and one skilled in the art certainly would not have made such a modification.

Therefore, given the fact that neither Fletcher et al. nor Miller et al. discloses, teaches or suggests a stepped configuration wherein two planes in which the generally flat first and second sections lie are offset from each other (as already recognized by the Examiner), given the fact that Atkinson et al. does not disclose, teach or suggest a second plane (i.e., a plane in which lies the generally flat forward section and the cutting edge) being offset from a the first plane (i.e., the plane in which lies the generally flat rearward section), and given the fact that it would not have been obvious to modify Atkinson et al. to arrive at such a

configuration, Applicant respectfully asks that the rejections of all claims be withdrawn in view of the above amendments to Claims 1 and 25.

For the foregoing reasons, Applicant respectfully submits that all pending claims, namely Claims 1-9, 13-17 and 25, are patentable over the references of record, and earnestly solicits allowance of the same.

Respectfully submitted,

November 2, 2010

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